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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------------|------------------|
| 10/672,717 | 09/26/2003 | Mark Willer | 066042-9415-01 | 1118 |
| 23409 | 7590 | 01/19/2005 | | |
| MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202 | | | EXAMINER PAYER, HWEI SIU CHOU | |
| | | | ART UNIT 3724 | PAPER NUMBER |
| DATE MAILED: 01/19/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/672,717 | Applicant(s) WILLER ET AL. | |
| | Examiner Hwei-Siu C. Payer | Art Unit 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32, 34-38, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 44 and 45 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10, 11, 18-23, 25-29 and 34-37 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 12, 14-17, 24, 30, 31, 32 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

The amendment filed on 12-17-2004 has been entered.

Claims Rejection - 35 U.S.C. 102(b)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 22, 23, 25-27, 29, 34 and 35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reprogle (U.S. Patent No. 2,367,432).

Reprogle discloses a saw comprising a housing (1,8), a motor (see column 2, lines 16-17), a saw blade (10), a first cover (12), a second cover (13), and a shoe plate (21) as claimed.

Claims Rejection - 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reprogle (U.S. Patent No. 2,367,432).

Reprogle's saw as set forth shows all the claimed structure except the first cover (12) is not semicircular in shape.

However, the claimed semicircular shape of the first cover is not patentably distinct over Reprogle since it has been held that change in shape is an obvious matter of engineering design choice and not patentably advanced. In re Dailey, 149 USPQ 47, CCPA 1966.

3. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reprogle (U.S. Patent No. 2,367,432) in view of Allison (U.S. Patent No. 5,542,183).

Reprogle's saw as set forth shows all the claimed structure except it is silent about whether or not the member (18) is "quick-locking" without the use of tools.

Allison teaches the use of a latch (124/126, see Fig.32) for a quick-locking of one element (132) to the other (20, see column 5, lines 52 to column 6, lines 1-5) without the use of tools.

It would have been obvious to one skilled in the art to modify Reprogle by substituting Allison's quick-locking latch for Reprogle's fastener (18) to facilitate a quick locking and unlocking of elements without the use of tools for time saving purpose as taught by Allison. Further, whether Reprogle's second cover (13) is locked to the housing (1,8) or to the first cover (12) is an obvious matter of personal preference and is, therefore, not patentably distinct.

4. Claims 1-3, 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reprogle (U.S. Patent No. 2,367,432) in view of Allison (U.S. Patent No. 5,542,183).

Reprogle discloses a saw comprising a housing (1,8,12), a motor (see column 2, lines 16-17), a saw blade (10), a cover (13), a locking member (18), and a shoe plate (21) substantially as claimed except it is silent about whether or not the member (18) is "quick-locking" without the use of tools, and the handle portion (19) is on the cover (13) rather than on the housing (12).

Allison teaches the use of a latch (124/126, see Fig.32) cooperating with a second locking assembly in the form of an indentation (120/122) for a quick-locking of one element (132) to the other (20, see column 5, lines 52 to column 6, lines 1-5) without the use of tools.

It would have been obvious to one skilled in the art to modify Reprogle by substituting Allison's quick-locking latch-and-indentation arrangement for Reprogle's fastener (18) to facilitate a quick locking and unlocking of elements without the use of tools for time saving purpose as taught by Allison.

As to the location of the handle portion (19), it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Reprogle by having the handle portion (19) arranged on the housing (12), since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70 (CCPA 1950).

Indication of Allowable Subject Matter

1. Claims 4, 5, 12, 14-17, 24, 30-32 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 9, 44 and 45 are allowed.

Remarks

Applicant's arguments with respect to claims 1-3, 7, 8, 10, 11, 18-23, 25-29 and 34-37 have been considered but are moot in view of the new ground(s) of rejection.

Action Made Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3724

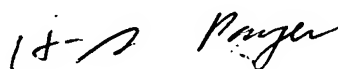
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax numbers for the organization where this application or proceeding is assigned are 703-872-9306 for official communications and 571-273-4511 for proposed amendments.

H Payer
January 18, 2005



Hwei-Siu Payer
Primary Examiner